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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/052,332

01/17/2002

David Hall

1182

7590

11/07/2005

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EXAMINER

ABEDIN, SHANTO

ART UNIT

PAPER NUMBER

2136

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,332

Applicant(s)

HALL, DAVID

Examiner

Shanto Abedin

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-16 were presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 5 are rejected under 35 USC 102 (b) as being anticipated by Schlauch (Patent No: US 6082774).

Regarding claim 1, Schlauch discloses an authenticated memorabilia system (Col 12-16, List of reference numerals; claims 25- 38; Claims 1-35; memorabilia article, authentication statement), the system comprising: a housing, the housing having front and rear portions, the front and rear portions including mirror-image indentations, the indentations defining receptacles when the housing portions are mated together (Col 12, 25, 26, 36; Claims 1-5, 9-11, 111; surface area of base article, and another surface area adjacent and outside of that surface are; affixed surfaces, observe and reverse sides of the surface are; unified body of tangible material; Packaged memorabilia, Col 12, items 101, 102; Col 14, item 910; Col 16, items 2240, 2245, 2246, 2247; masking removably attached to base article); a memorabilia article disposed in first one of the receptacles (Col 12, 13; items 193, 293, 393: pictorial image; Fig 2A, 2B, 3A, 3B, 4A, 4B, 11A; memorabilia article; Claim 1, base article); an identification tag disposed in a second one of the receptacles, the identification tag including an authenticated autograph of a unique individual associated with the memorabilia article (Col 25, Claim 5, authentication statement, Col 26, Claim 9, autograph of preferred personality; Fig 1A, element 130: autograph); and wherein the front and rear housing portions are constructed of a substantially transparent material such that a front and rear surface of the memorabilia article and a front and rear surface of the identification tag are visible through the front and rear housing portions (Col 9, lines 5-25, clear surface; Col 11, lines 5-50; Figures 1A, 1B, 2A, 2B; viewable observe and reverse sides; Col 35-37 Claims 105, 111, 119, plastic material).

Regarding claim 2, it is rejected applying as above rejecting claim 1, furthermore, Schlauch discloses the memorabilia system, wherein the housing portions are constructed of a clear thermoplastic material which does not offer any impairment to visualization of either the memorabilia article or the identification tag (Col 9, lines 5-25, clear surface; Col 11, lines 5-50; Figures 1A, 1B, 2A, 2B; viewable observe and reverse sides; Col 35-37 Claims 105, 111, 119, plastic material).

Regarding claim 3, it is rejected applying as above rejecting claim 2, furthermore, Schlauch discloses the memorabilia system, wherein both surfaces of the identification tag containing identification and authentication indicia, the front face of the identification tag including text which identifies the issuing entity and text identifying the memorabilia article contained within the receptacle (Fig 1A, 1B, elements 100, 120: viewable texts in observe and reverse sides, element 140: fingerprint, element 120: information about fingerprints; Fig 4A, 4B, element 440: fingerprint in observe side, elements 450, 460, 480: autograph, authenticating text in reverse side; Col 25-27, claims 1-15, authentication statement, genuine autograph, and fingerprint of preferred personality; Col 36, Claim 111, numeric and text indicium).

Regarding claim 4, it is rejected applying as above rejecting claim 3, furthermore, Schlauch discloses the memorabilia system, wherein a portion of the front face of the identification tag includes an area reserved for a grading mark, the grading mark providing an indication of a collectable condition designation of the memorabilia article, the identification tag further including a numerical designator indicating the quality degree within a particular condition designation (Col 27, Claim 13; Fig 1A, 1B, 2A, 2B; LIMITED EDITION, LIMITED SERIES markings; elements: 200, 220: Card number, series number, number of copies, edition etc; Col 36, Claim 111, numeric and text indicium).

Regarding claim 5, it is rejected applying as above rejecting claim 4, furthermore, Schlauch discloses the memorabilia system, wherein the identification tag further includes a serial number, the serial number comprising a unique alpha or alpha numeric sequence which specifically identifies the memorabilia article disposed within the housing (Col 36, Claim 111, numeric and text indicium, unique number).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 6 is rejected under 35 USC 103 (a) as being unpatentable over Schlauch (Patent No: US 6082774) in view of Soules et al (Patent No: US 5522623).

Regarding claim 6, it is rejected applying as above rejecting claim 5, furthermore, Schlauch discloses the memorabilia system according to claim 5, the identification tag further including: a marker area (Fig 1A, 1B, item 140, fingerprint; Col 29, Claim 43; Col 30, claim 54; fingerprint; Col 32; Claim 68, fingerprint; Fig 12A; Col 11, lines 15-27, fingerprint area). Schlauch further discloses a biological marker to be used in memorabilia article (Fig 1A, 1B, item 140, fingerprint; Col 29, Claim 43; Col 30, claim 54; fingerprint; Col 32; Claim 68, fingerprint; Fig 12A; Col 11, lines 15-27, fingerprint area). Schlauch does not expressly disclose that the biological marker is invisible to the naked eye and only visible under light in specific wavelengths, the presence of the biological marker providing an indication of authenticity of the memorabilia article. However, Soules et al discloses a biological marker invisible to the naked eye and only visible under light in specific wavelengths, the presence of the biological marker providing an indication of authenticity (Fig 1, element 16; Col 3, lines 50-55; fingerprint; Col 12, Claim 1, indicia (barcode) is visible only in specific wavelength, and readable by machine. At the time of invention, it would be obvious to an ordinary skill in the art to use similar technique to design a memorabilia comprising a biological mark which is only visible through specific wavelength). At the time of invention, it will be obvious to a person with ordinary skill in the art to combine the teachings of Soules et al with Schlauch to design a memorabilia containing a biological security marking which is invisible in naked eyes, but visible in lights in different wavelength. Motivation for doing so would have been that such human invisible biological security markings are commonly used in the security articles for authentication purposes, or to provide a tamper-proof mechanism for security articles (Soules et al, Col 11, lines 5-11).

4. Claims 7- 13 are rejected under 35 USC 103 (a) as being unpatentable over Schlauch (Patent No: US 6082774) in view of DiCesare et al (Patent No: US 5971435).

Regarding claim 8, it recites limitations of claim 1, therefore it is rejected applying as above rejecting claim 1. Furthermore, DiCesare et al discloses a method for authenticating a memorabilia article, the method comprising: the autograph being inscribed on the tag in the presence of an agent of a recognized authentication service (Col 5, Claim 1, representative of authentication service); encapsulating the memorabilia article and the identification tag in a housing within an encapsulation facility under the supervision of the authentication service (Col 5, Claim 1, representative of authentication service, witnessing autographing); and permanently sealing the housing along a periphery, such that neither the article nor the tag may be removed therefrom without providing visible indications of tampering on the housing (Col 5-6, Claim 1, representative of authentication service, witnessing the autographing; Col 5, lines 15-21, affixed the article with tamperproof adhesive). At the time of invention, it will be obvious to a person with ordinary skill in the art to combine the teachings of DiCesare et al with Schlauch to design a memorabilia system further comprising an authentication services providing authentication supervision. Motivation for doing so would have been simply to provide consumers with tamperproof authenticated memorabilia (DiCesare et al, Col 5, lines 3-22), or to ensure greater article security (DiCesare, Col 2, lines 31-36).

Regarding claim 7, it is rejected applying as above rejecting claim 5, furthermore, although Schlauch discloses a visual authentication for the memorabilia system (Col 25, Claim 5), and the unique number associated with such memorabilia (Col 36, Claim 111, numeric and text indicium, unique number), Schlauch does not expressly disclose a memorabilia system further comprising an authentication service, a memorabilia article registration database, maintained by the authentication service; and wherein the unique serial number is associated to the specific memorabilia article in the database. However, DiCesare et al discloses a memorabilia system further comprising an authentication service (Col 3, lines 4- 35; a certificate of authenticity; Col 5-6, lines 10-20, Claim 1, authentication company/ system), a memorabilia article registration database, maintained by the authentication service (Col 3, lines 4- 35; a certificate of authenticity, database containing certificate of authenticity, an identifying code associated with each article; Col 5-6, lines 10-20, Claim 1, authentication company/ system); and wherein the unique serial number is associated to the specific memorabilia article in the database (Col 3, lines 4- 35; a certificate of authenticity, database containing certificate of authenticity, and unique identifying code associated with each article). At the time of

invention, it will be obvious to a person with ordinary skill in the art to combine the teachings of DiCesare et al with Schlauch to design a memorabilia system further comprising an authentication service, and database for registering authenticated memorabilia. Motivation for doing so would have been simply to provide consumers with tamperproof authenticated memorabilia (DiCesare et al, Col 5, lines 3-22).

Regarding claim 9, it recites the limitations of claims 1,2, and 8. Therefore, it is rejected applying as above rejecting claims 1, 2, and 8.

Regarding claim 10, it recites the limitations of claims 3, and 9. Therefore, it is rejected applying as above rejecting claims 3, and 9.

Regarding claim 11, it recites the limitations of claims 4, and 10. Therefore, it is rejected applying as above rejecting claims 4, and 10.

Regarding claim 12, it recites the limitations of claims 5, and 11. Therefore, it is rejected applying as above rejecting claims 5, and 11.

Regarding claim 13, it recites the limitations of claims 6, and 12. Therefore, it is rejected applying as above rejecting claims 6, and 12.

5. Claims 14- 16 are rejected under 35 USC 103 (a) as being unpatentable over Schlauch (Patent No: US 6082774) in view of Soules et al (Patent No: US 5522623), further in view of DiCesare et al (Patent No: US 5971435).

Regarding claim 14, it recites the limitations of claims 7, and 13. Therefore, it is rejected applying as above rejecting claims 7, and 13. Schlauch, Soules et al, and DiCesare et al are analogous art because they are from the same field of endeavor of authenticating security documents. At the time of invention, it will be obvious to a person with ordinary skill in the art to combine modified Schlauch- Soules et al system with DiCesare et al to design a memorabilia system comprising a registration database, and an unique serial number associated with each memorabilia. Motivation for doing so would have been to provide consumers with tamperproof authenticated memorabilia or security items (DiCesare et al, Col 5, lines 3-22).

Regarding claim 15, it recites limitations of claims 8, and 14. Therefore it is rejected applying as above claims 8, and 14. Furthermore, DiCesare et al discloses tracking and identifying encapsulated memorabilia article by its unique serial number (Fig 1, code number; Fig 3A, element 16, code number); verifying the serial number pertains to the corresponding memorabilia item (Fig 1, code

number; Fig 3A, element 16, code number; Col 2, lines 1-5; Col 5-6, Claim 1, verifying/ matching code number); and verifying the authenticity of an article by a designation of origin and a lack of tamper evidence on their housing (Col 1, lines 51-57; Col 3, lines 27-32; tamper proof adhesive).

Regarding claim 16, it recites limitations of claims 6, and 15. Therefore it is rejected applying as above claims 6, and 15.

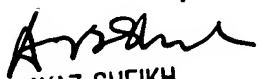
Conclusion

6. A shortened statutory period for response to this action is set to expire in 3 (Three) months and 0 (Zero) days from the mailing date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C 133, M.P.E.P 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 2136


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